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CHARLES ELMORE CR  
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IN THE  
**Supreme Court of the United States**

OCTOBER TERM, 1948.

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**No. 790**

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SALES AFFILIATES, INC.,

*Petitioner,*

*vs.*

NATIONAL MINERAL COMPANY, NOW, BY CHANGE OF  
NAME, HELENE CURTIS INDUSTRIES, INC.,

*Respondent.*

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**BRIEF FOR RESPONDENT IN OPPOSITION TO  
PETITION FOR WRIT OF CERTIORARI.**

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**Petitioner Does Not Set Forth an Adequate Reason for  
Granting the Writ.**

MAY IT PLEASE THE COURT:

This is an ordinary patent case in which the Court of Appeals for the Seventh Circuit held two of petitioner's patents invalid for want of invention.

The conditions upon which this Court should grant a Writ of Certiorari are set forth in *Layne & Bowler Corp. v. Western Well Works*, 261 U. S. 387, 393 (1923):

“ \* \* \* it is very important that we be consistent in not granting the writ of certiorari except in cases involving principles the settlement of which is of im-

portance to the public as distinguished from that of the parties, and in cases where there is a real and embarrassing conflict of opinion and authority between the Circuit Courts of Appeal. The present case certainly comes under neither head."

This Court further emphasized these two conditions in its decision in *Magnum Import Co., Inc. v. Coty*, 262 U. S. 159, 163 (1923):

"The jurisdiction was not conferred upon this Court merely to give the defeated party in the Circuit Court of Appeals another hearing."

Neither of the two requisite conditions to the granting of petitions for Writs of Certiorari is present in the case at bar. There is no conflict between Courts of Appeal regarding the validity, scope or infringement of the patents in suit. No basic issue of public importance is raised by the petition and no novel principle of patent law is involved. Nor does the petition present "special and important reasons," as required by Rule 38 (5) of the Rules of this Court.

This is an ordinary patent case and the only question involved is that of the validity of Winkel Patent No. 2,051,063 and Evans and McDonough Reissue Patent No. Re. 22,660.

The statement of this Court in *Keller v. Adams-Campbell Co.* 264 U. S. 314, 319 (1924), therefore, is controlling:

"Such an ordinary patent case, with the usual issues of invention, breadth of claims, and non-infringement, this Court will not bring here by certiorari unless it be necessary to reconcile decisions of Circuit Courts of Appeal on the same patent."

A reading of the opinion of the Court of Appeals for the Seventh Circuit, 172 F. (2d) 608 (C. A. 7th, 1949) (R. 1609), reveals that the conclusion of invalidity is in

harmony, and not in conflict, with applicable decisions of this Supreme Court. It is manifest that in these circumstances, the petition should be denied.

**Petitioner's Statement of Facts Presents a Fragmentary and Misleading Review of the Case.**

The petition and supporting brief omit essential facts necessary to an understanding of the matter involved. Accordingly, the basic facts will be restated and we shall then show that the reasons relied upon for allowance of the writ are wholly devoid of merit.

1. Petitioner's patents relate to chemical heating means used in permanent hair waving operations. Permanent waving of hair on a living head is an old art which produces certain changes in straight hair to cause it to remain curly after wetting. Basically, the method and steps followed in the operation of giving a permanent wave, in which heat is used, are:

- (a) to wind the strands of hair on curlers,
- (b) to apply chemical waving lotion to the hair,
- (c) to heat the wound and treated hair for a pre-determined period of time, and
- (d) to permit the hair to cool on the curlers until absolutely cold before removing the hair strands therefrom.

The source of the heat used to permanently wave the hair does not in any way alter or modify the basic steps necessary in the operation. The function performed by the heating means is the same regardless of the source of the heat that is used in giving the permanent wave, whether the heat source be steam, electrical means, or chemical heating pads of the type involved in the patents in suit.

2. The prior art shows chemical heating pads for use in permanent waving of hair upon a living human head.

These prior patented pads contain the same chemical ingredient (calcium oxide) that is disclosed in the Winkel patent. The chemical pads of the prior art are wrapped around a preformed tress and supply the heat required to impart a permanent wave to the hair. The exothermic reaction of the chemical is brought about by placing a wetted absorbent member in contact with the chemical-containing envelope of the prior art pads (R. 1426).

Like the specific construction of the Winkel pad, the prior art discloses pads, used in the permanent waving of hair, having a backing sheet of impervious material, to the front face of which is attached an impervious envelope containing a chemical, one face of the envelope being perforated to permit the chemical contained therein to act upon the hair during the hair waving operation (R. 1446).

3. The Winkel device is extremely simple and the patent covering the device is readily understood. It does not require experts to explain the construction of the device claimed in the Winkel Patent. Petitioner's introduction of expert testimony, purporting to be an explanation of the Winkel disclosure, served more to confuse than to clarify.

At the trial there was only one demonstrating operation of the pad disclosed in the Winkel patent. That demonstration consisted of nothing more than the placing of a pad, constructed in accordance with the Winkel Patent disclosure, around a wound strand of hair on but a single curler rod. This demonstration **was not made on a living human head** (R. 313). All other demonstrations by petitioner were made with petitioner's commercial pads which are different in structure and mode of operation from the Winkel pads of the patent in suit in that they incorporate essential developments made later by others.

4. For the convenience of this Court, facing this page



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is a chart<sup>1</sup> illustrating the Winkel pad, the Sartory Patent disclosure held by the Court of Appeals substantially to anticipate the Winkel patent, the prior art Frederics and Lackenbach hair waving pads, and one of the accused pad structures of respondent.

5. Petitioner refers to extended arguments before the District Court on the proposed findings of fact submitted by the petitioner. The findings of fact and conclusions of law adopted by the Court with respect to these two patents are almost entirely word for word as proposed by petitioner. In this connection, it is interesting to note the following comment by the District Court in response to an objection raised by respondent's counsel to the adoption of a finding which in the opinion of respondent's counsel was not supported by the record (R. 621):

"The Court: He says it does, and you say it doesn't. Now, when you get up to the Court of Appeals, one of you is going to win and one of you is going to lose. *That is going to be the contest up there.* If he can't sustain it, that will be his hard luck." (Italics ours.)

6. The record clearly shows that the Winkel pad, using lime alone as the heating chemical was a complete commercial failure. Only a very few of the Winkel pads were sold in 1931 and 1932, and none at all after 1932 (R. 155, 508).

The undisputed facts are that for a period of nearly sixteen years not a single competitor recognized the Winkel Patent to the extent of taking a license under it or paying any royalties therefor; that for a period of nearly twelve years after the issuance of the Winkel Patent no one re-

<sup>1</sup> In this chart we have used the following color scheme: Yellow to designate the backing sheet or clamp, Green to designate the absorbent sheet, and Orange to designate the chemical-containing envelope.

spected that patent sufficiently to take a license under it. This in spite of the fact that petitioner is only one of many manufacturers of machineless pads embodying the alleged Winkel invention.

7. In reading petitioner's statement on page 3 of its petition, regarding the prior art, it must be kept in mind that there are several Sartory patents in this Record (R. 1426-1443). Petitioner there refers solely to the patent on the Sartory machine—**not that on the Sartory pad**. This small Sartory **pad** should not be confused with the Sartory **machine** (P. Ex. 17) (Compare R. 1436 with R. 1430). The latter has no bearing whatsoever on the issues involved here and is a prior art device upon which the defendant **does not** rely.

8. The Winkel and Sartory pads are substantially the same in structure, mode of operation and result. Winkel's disclosure amounts to nothing more than directions for applying a chemical heating pad in a permanent hair waving process. This is exactly what Sartory taught in his patents. In Sartory, just as in Winkel, there is a preformed tress which has been prepared to receive the permanent wave. It is clear from the record that such preparation of the hair includes the application of moisture to it (R. 171). In Sartory, as in Winkel, the tress is enclosed within a pad which contains the exothermic chemical which, in both Sartory and Winkel, consists of lime. Sartory clearly teaches that this chemical will of itself generate sufficient heat to impart a wave to the tress. The exothermic reaction in Sartory, just as in Winkel, is produced by providing in the heating unit a moistened sheet for contact with the chemical.

9. The conclusion of the Court of Appeals that Sartory anticipates Winkel is inevitable, and any other conclusion is clearly erroneous, upon comparison of the respective disclosures of Sartory and Winkel, quotations from each

of which appear in footnote on page 611 of 172 F. (2d), (R. 1613) where the opinion of the Court of Appeals in the instant case is reported.

10. The District Court made no finding of fact respecting the Sartory pad. Findings 9, 10 and 21, referred to by petitioner, do not relate to the Sartory **pad**. They relate only to the irrelevant Sartory **machine**.

11. The Evans and McDonough Reissue Patent No. 22,660 is entitled "Method of and Means for Waiving Hair" (R. 1382). Actually this reissue patent discloses nothing more than a chemical heater containing a mixture of chemical ingredients which, when wetted with water, will generate heat. The patent states that the particular purpose for which the heat is generated is for use in permanent hair waving. The composition of the reissue patent makes use of an old combination of chemical ingredients which react exothermically with water. The heat produced by the prior art compositions is in accordance with a desired time-temperature relationship.

12. Baker Patent No. 1,760,102 completely anticipates Reissue Patent No. 22,660. Every element disclosed and claimed in the Reissue patent is present in the exothermic heating composition of the Baker patent. The only difference between Baker and some of the claims of the Reissue Patent is that the specific proportions of some of the chemicals are varied to provide slightly higher temperatures than are secured by Baker's warming pad so as to be better adapted for hair waving operations. Baker made it clear that what he was claiming was a heating pad utilizing an exothermic reaction. A chemical heating pad for body warming is one example of such a pad; a chemical heating pad for waving hair is another. This was recognized by the patentees of the Reissue Patent in suit when they said that their invention relates generally to the art of chemical heaters.

13. The Court of Appeals followed the recent decision of this Court in *Mandel Bros. Inc. v. Wallace*, 335 U. S. 291 (1948) and held that Baker and the reissue patentees were both dealing with the same scientific creation, that is, chemical generating heaters.

14. There is no question of credibility of witnesses and no substantial differences exist in the testimony of the experts for both parties.

15. The Court of Appeals carefully reviewed the evidence and the findings of the District Court. The Court of Appeals said:

“We have examined the record carefully and we are unable to find anything in the evidence indicating that in this slight variation, Winkel accomplished anything in the way of invention. Indeed we do not find any change by Winkel that amounted to improvement of any character.” (172 F. (2d) 608, 611 (C. A. 7th, 1949) (R. 1612-13).)

16. Plaintiff filed a petition for rehearing as to the Winkel Patent only. No petition for rehearing was filed as to the Reissue Patent.

THE REASONS RELIED UPON BY PETITIONER ARE  
WHOLLY DEVOID OF MERIT.

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The several reasons upon which the petition is based will be considered briefly in the order in which they appear in the petition.

I.

**The Decision Here Is in Harmony with Applicable  
Decisions of This Court.**

The first two of the several reasons relied upon by the petitioner for the allowance of the petition for a Writ of Certiorari are substantially the same and are based on an argument that the Court of Appeals has not followed the provisions of Rule 52(a) of the Rules of Civil Procedure and the decision of this Court in *Graver Tank and Manufacturing Co., Inc. v. Linde Air Products*, 336 U. S. 271 (1949).

In *Graver v. Linde*,<sup>2</sup> the District Court held four flux claims valid and infringed, and other flux claims and all process claims invalid. The Court of Appeals affirmed as to the holding of validity and infringement of the four flux claims, but reversed as to the remaining flux claims and the process claims, and held them also valid and infringed. There the patents dealt with complicated electrical questions involving electrical arc phenomena which experts cannot explain. It appeared also that the District Court visited laboratories, viewed motion pictures of various welding operations and tests and "heard many experts". No such situation exists here.

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<sup>2</sup> Now pending on reargument ordered pursuant to a Petition for Rehearing.

In that case this Court held that the ultimate question of patentability is a question of law and agreed with the lower courts that as to the four flux claims held valid the statutory requirements had been met, saying:

“\* \* \* While the ultimate question of patentability is one of meeting the requirements of the statute Rev. Stat. Sec. 4886, as amended, 35 USCA Sec. 31, 9 FCA title 35, Sec. 31, the facts as found with respect to these four flux claims warrant a conclusion here that as matter of law those statutory requirements have been met.”

As to the remaining flux claims, this Court reversed the judgment of the Court of Appeals and agreed with the District Court that the statutory requirements had not been met.

Thus, in the case at bar, in deciding that the ultimate question of patentability is a question of law, the Court of Appeals clearly followed this Court's decision in the *Graver* case and, also, the earlier decisions of this Court in *Heald v. Rice*, 104 U. S. 737 (1882); *Singer Mfg. Co. v. Cramer*, 192 U. S. 265 (1904); and *Sanitary Refrigerator Co. v. Winters*, 280 U. S. 30 (1929) (R. 1616).

In the *Graver* case, (336 U. S. 271) this Court further said:

“Just what happens in the Jones method admits of controversy, for there is no visual evidence of an electric arc after the welding operation commences because what actually occurs between the electrode and the metal base is hidden from view by the flux. The court concluded that it is impossible to say with complete certainty that there is not an arc and one of the plaintiff's expert witnesses gave substantial support to the idea that the arc is still present, although it is shielded by the flux in the Jones patent.”

No such situation exists here. In the case at bar the patents in suit disclose extremely simple and readily

understood devices. Expert testimony to explain them is not required; and the experts agreed as to the construction and mode of operation.

The differences referred to by petitioner relate only to differences between the testimony of petitioner's experts at the trial and the admissions and representations made by petitioner to the Patent Office to induce the issuance of other patents to petitioner.

**The Court of Appeals Did Not Misinterpret Rule 52 (a)  
F. R. C. P.**

Petitioner also says that the Court of Appeals misinterprets Rule 52(a) F. R. C. P. The pertinent portion of the rule is as follows:

*"Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge the credibility of the witnesses."* (Italics ours.)

Petitioner stresses only a portion of the rule and entirely ignores the portion which has been emphasized in italics here. In the present case there is no question whatever of the credibility of any witness. The Court's decision does not turn on testimony of witnesses, but in consideration of the legal effect of the prior patented art.

Briefly stated, petitioner's contentions on pages 15-25 of its supporting brief appear to be that, first, the question of validity is a question of fact, and, second, that the Court of Appeals cannot reverse a finding of validity as a fact if there is any evidence whatever to support such a finding.

While the question as to whether validity is properly a finding of fact or a conclusion of law is apparently somewhat confused in the published decisions, it is obvious that a holding of validity is subject to review by an appellate tribunal and subject to reversal. It is unnecessary to cite



the large number of cases in which Courts of Appeal have reviewed decisions of District Courts and reversed findings of such courts as to validity. It is equally true that this Court, in a substantial number of its decisions in patent cases, has reversed findings of lower tribunals holding patents valid, and has held them invalid. It certainly cannot be argued that in all such cases there was no basis whatever for the finding of the lower tribunal or tribunals.

To go back to the question as to whether validity is properly a finding of fact or a conclusion of law, it is desired to point out that the decisions cited by petitioner on page 24 of its brief as supporting the finding of fact theory do not, in fact, support that theory.

The first decision cited is *Thompson v. Ford*, 265 U. S. 445. This Court did not there declare that validity is a question of fact. This Court held only that the question whether an improvement requires mere mechanical skill or the exercise of the faculty of invention is one of fact.

The next case cited, that of *United States v. Esnault-Pelterie*, 299 U. S. 201, was a decision of this Court reviewing a decision in a patent case by the Court of Claims. It shows the position of this Court as to the matter of validity being a conclusion of law rather than a finding of fact. On that point, the decision is directly contrary to the purpose for which it was apparently cited by petitioner. At page 202 of that decision this Court states:

“The record does not show whether at first the conclusion of law contained any statement as to validity or infringement.”

And, at page 203, this Court quotes the conclusion of law of the Court of Claims, as follows:

“Upon the foregoing special findings of fact, which are made a part of the judgment herein, the Court decides as a conclusion of law that the plaintiff's pat-

ent is valid and has been infringed by the United States and that he is entitled to compensation therefor under the Act of June 25, 1910."

Further, on page 206, this Court made the following pertinent statement:

"The failure of the lower court to make special findings upon the main issues does not lay upon this court the duty of examining, analyzing and comparing the circumstantial facts found to ascertain whether as a matter of law they establish validity and infringement."

This same case later came up again before this Court, and is reported in *United States v. Esnault-Pelterie*, 303 U. S. 26, 30 (1938), where this Court, by way of dicta, said:

"We are not unmindful of the rule that where, with all the evidence before the Court it appears that no substantial dispute of fact is presented, and that the case may be determined by a mere comparison of structure and extrinsic evidence is not needed for purposes of explanation, or evaluation of prior art, or to resolve questions of the application of descriptions to subject matter, the questions of invention and infringement may be determined as questions of law."

While the statement quoted above was merely *dicta* so far as the case in which it appears is concerned, yet it affords a very reasonable reconciliation between decisions which have held that validity and infringement are questions of fact and those which have held them to be questions of law. If the question of invention is determined by merely a comparison of the undisputed disclosures of the prior patents with that of the patent in suit, without requiring expert testimony and without presenting any disputed questions of fact, as in the case at bar, a question of law is presented. Likewise, the question of infringement is

merely one of law, if it requires, as in the instant case, only a comparison of the plaintiff's patent with the accused device, as to the construction and operation of which there is no dispute.

*Heald v. Rice*, 104 U. S. 737 (1882), was an action at law on a reissue patent which was tried by a jury and resulted in a verdict and judgment for the plaintiff. A writ of error was prosecuted to reverse the judgment. One of the questions presented was whether the disclosures in two patents (the original and the reissue) were identical. This Court said, at page 749:

“\* \* \* that is, if it appears from the face of the instruments (patents) that extrinsic evidence is not needed to explain terms of art, or to apply the descriptions to the subject matter, so that the Court is able from mere comparison to say what are the inventions described in each, and to affirm from such mere comparison that they are not the same, but different, then the question of identity is one of pure construction, and not of evidence and, consequently, is matter of law for the Court, without any auxiliary matter of fact to be passed upon by a jury, if the action be at law.”

This Court, in *Heald v. Rice*, *supra*, then proceeded to compare the original patent with the reissue patent and decided that the two were not for the same invention.

Precisely the same situation exists in the present case. The patents in suit and those of the prior art deal with the most simple of devices. No extrinsic evidence to explain them is needed; and there is no dispute about their disclosures.

Finally, petitioner cites *Williams Mfg. Co. v. United Shoe Machinery Corp.*, 316 U. S. 364 (1942), where the validity of certain claims of a patent on heel-lasting machines was sustained. This Court, on page 365, stated:

“In pressing us to grant the writ, the petitioner

insisted that it desired no retrial of the facts but merely a proper application of the law to the facts found by the courts below. We granted the writ."

In the present case that is exactly the action taken by the Court of Appeals for the Seventh Circuit. They properly applied the law to the facts as found by the court below. In the cited case there were concurrent findings of the District Court and the Court of Appeals that there were new combinations which produced an improved result. In the *Williams* case, this Court held the finding of an improved result "was a finding of fact." Nevertheless, it did not merely affirm on the basis that there was supporting evidence. It reviewed the case to determine whether the factual "improved result" constituted "patentable invention."

On page 16 of its brief, petitioner says that the Court of Appeals disregarded pertinent findings and ignored much of the testimony, exhibits and results of scientific tests and demonstrations. There is no basis in the record for such a statement. The Court of Appeals made it clear that it carefully reviewed the entire record and gave full and careful consideration to the findings of the trial court (R. 1612-13).

In the case at bar the Court of Appeals did not find as to the facts any differently from the trial court. It accepted the facts, however, and determined that, as a matter of law, these facts proved definitely that both patents are invalid.

Another decision of this Court, which bears on the question as to whether or not infringement or validity are questions of fact or of law, is *Market St. Ry. Co. v. Rowley*, 155 U. S. 621, 625 (1895), where this Court made the following statement:

"The defendant put in evidence a number of patents prior in date to the plaintiff's, and asked the court to

compare the inventions and devices therein described with those claimed by the plaintiff. No extrinsic evidence was given or needed to explain terms of art, or to apply the descriptions to the subject matter, so that the court was able, from mere comparison, to say what was the invention described in each, and to affirm from such mere comparison whether the inventions were or were not the same. The question was, then, one of pure construction and not of evidence, and consequently was matter of law for the court, without any auxiliary fact to be passed upon by the jury."

In the present case, the facts are undisputed and the question of validity has equally resolved itself into one of law, in this case depending upon a comparison between the claims and structures disclosed on the face of the patents and the prior art patents before the court.

## II.

### **No Conflict of Decisions Is Shown by Petitioner.**

Petitioner's next point is that the Court of Appeals for the Seventh Circuit is alone in holding that patentable invention is a question of law. The decisions of the Court of Appeals for the Seventh Circuit in the two cases cited by petitioner, *National Slug Rejectors, Inc. v. A. B. T. Mfg. Corp.*, 164 F. (2d) 333 (C. A. 7th, 1947) (cert. den. 68 S. Ct. 459), and *Loney Co. v. Ravenscroft*, 162 F. (2d) 703 (C. A. 7th, 1947), are in harmony with the decision of this Court in the recent case of *Graver Tank and Manufacturing Co., Inc. v. Linde Air Products*, 336 U. S. 271 (1949).

In *Loney Co. v. Ravenscroft*, *supra*, at 704, the Court of Appeals for the Seventh Circuit held:

"There are four ultimate facts required to be established by an applicant before he can obtain a patent. They are invention or discovery, authorship, novelty, and utility. Other specific requirements are set forth

in the statute, 35 USCA, Sec. 31, but they all pertain to the question of novelty or authorship. If all ultimate facts are found and are substantially supported by evidentiary facts, which of course need not be incorporated in the findings of fact, then the court should conclude as a matter of law that the disclosure is patentable, otherwise not."

And in *National Slug Rejectors, Inc. v. A. B. T. Manufacturing Corp.*, 164 F. (2d) 333, the same Court of Appeals merely followed its earlier decision in *Loney v. Ravenscroft*, *supra*.

Clearly, this is tantamount to holding, as this Court held, in *Graver v. Linde*, 336 U. S. 271, that the ultimate question of patentability is one of meeting the requirements of the patent statute R. S. Sec. 4886 and is a question of law.

### III.

#### **No Novel Principles of Patent Law Are Involved.**

The next reason advanced by petitioner for the allowance of the petition for writ of certiorari is the contention that the Patent Office determination that claims define patentable invention should not be set aside unless clearly erroneous.

A decisive answer to this contention is that this Court has on numerous occasions held that the Patent Office determination is not final, but creates a presumption of validity only. *Smith v. Goodyear Vulcanite Co.*, 93 U. S. 486 (1877); *Lehnbeuter v. Holthaus*, 105 U. S. 94 (1882); *Cantrell v. Wallick*, 117 U. S. 689 (1886); *Mumm v. Decker & Sons*, 301 U. S. 168 (1937); *Radio Corp. of America v. Radio Engineering Labs.*, 293 U. S. 1 (1934).

Petitioner says in its supporting brief, at page 26, that no case of this Court has been found which passed upon

the question of the weight which should be accorded to the Patent Office administrative determination that claims define invention. Evidently petitioner overlooked the decisions of this Court in *Reckendorfer v. Faber*, 92 U. S. 347 (1876); *Andrews v. Hovey*, 124 U. S. 694 (1888); *Gardner v. Hertz*, 118 U. S. 180 (1886); *Woodbury Patent Planning Machine Co. v. Keith*, 101 U. S. 479 (1880); *U. S. Rifle & Cartridge Co. v. Whitney Arms Co.*, 118 U. S. 22 (1886); *James v. Campbell*, 194 U. S. 356 (1882), and others.

The contention now advanced by petitioner is not new. It was urged upon this Court as far back as 1876, in *Reckendorfer v. Faber*, 92 U. S. 347 (1876). After reviewing the patent statute, this Court there concluded that no one is entitled to a patent unless (1) he has invented or discovered an art, machine or manufacture, (2) which is new, (3) which is also useful and (4) which is not known or patented before the applicant's invention or discovery thereof. At page 350, this Court said:

"It is not sufficient that it is alleged or supposed, or even adjudged, by some officer, to possess these requisites. It must, in fact, possess them; and that it does possess them the claimant must be prepared to establish, in the mode in which all other claims are established; to wit, before the judicial tribunals of the country."

So similar are the arguments made by petitioner on pages 28 and 29 of its brief to those advanced by the patentee in *Reckendorfer v. Faber*, 92 U. S. 347 (1876) (referred to on pages 351-352) that one might have been patterned after the other. In the *Reckendorfer* case, the patentee contended that the question of invention, novelty and utility are all passed upon by the Commissioner and therefore should be accepted by the Court as conclusive. In answer to this contention, this Court said (pages 354-355):

"Upon the <sup>16</sup>proposition that the decision of the com-

missioner on the question of invention, its utility and importance, is conclusive, and that the same is not open to examination in the courts, we are unanimously of the opinion that the proposition is unsound. His decision in the allowance and issue of a patent creates a *prima facie* right only; and, upon all the questions involved therein, the validity of the patent is subject to an examination by the courts."

This Court then proceeded to decide the question of invention on precisely the same facts that were before the Commissioner of Patents and held that the two patents in suit were invalid for lack of invention.

The other decisions of this Court, which we cited on page 17 hereof, are to the same effect.

*Swayne & Hoyt v. U. S.*, 300 U. S. 297 (1937), and *Gray v. Powell*, 314 U. S. 402 (1941), cited by petitioner on page 27 of its brief, are not in point. An obvious distinction is that in each case the party against whom the administrative determination was made had been accorded full opportunity to be heard and to present evidence; whereas, in the case of the issuance of a patent, the proceedings are conducted *ex parte* and in secret; the defendant, as in the case at bar, was not a party and never had a hearing.

Yet another important difference is that in the particular statutes under which the parties proceeded in the cases relied upon by petitioners, Congress declared that the agency's fact determination be conclusive unless there is no evidence to support them, whereas, in the case of the Patent Office, Congress has shown a consistent intention that the Patent Office determination be *prima facie* only and that the issues of invention, utility, novelty and other statutory requirements be left to the courts for final adjudication. Thus, R. S. 4920 (35 U. S. C. A. 69) provides for such defenses when sued for infringement. Even in



*ex parte* cases, an applicant is given a trial *de novo* by a constitutional court (R. S. 4915, 35 U. S. C. A. 63).

Cogent reasons exist for adhering to the doctrine announced by this Court over seventy years ago, in *Reckendorfer v. Faber*, 92 U. S. 347 (1876), and consistently adhered to since then, not the least of which is the fact that proceedings for obtaining a patent are conducted in secret, to which the accused infringer is not a party and thus never had an opportunity to be heard.

#### IV.

##### **No New Issue of Public Importance Is Presented.**

The third point raised by petitioner is an allegation that this Court has never passed upon the question of whether a Patent Office determination of the issue of novelty is binding in an infringement action brought on the patent. Obviously, petitioner overlooked the numerous decisions of this Court where, on substantially the same evidence that was before the Patent Office, this Court has held patents invalid. A few of them are cited on pages 17 and 18 of this brief. Others are *Rubber Tip Pencil Co. v. Howard*, 20 Wall. 498 (1874); *Brown v. Piper*, 91 U. S. 37 (1875); *Sewall v. Jones*, 91 U. S. 171 (1875); and *Cohn v. United States Corset Co.*, 93 U. S. 366 (1876).

The case last cited is directly in point. There, the Patent Office allowed the patent in suit over a British Patent to Johnson. This Court compared the disclosure of the patent in suit with disclosure of the very same Johnson Patent and held that the Johnson Patent anticipated.

## V.

# There Has Been No Departure from the Accepted Course of Judicial Proceedings.

Petitioner's final point, that the Court of Appeals has departed from the accepted course of judicial proceedings, is merely a reargument of its first point, argued on pages 15-25 of its supporting brief. Petitioner attempts to make out a case of disagreement among the experts. There was none as to the construction and mode of operation of the devices of the patents in suit and those of the prior art. As the Court of Appeals found (R. 1616):

"This is not a case where findings of fact depend upon disputed evidence of controversial facts. \* \* \*"

The Court of Appeals was right in following the decisions of this Court in *Sanitary Refrigerator Co. v. Winters*, 280 U. S. 30 (1929) and in *Singer Mfg. Co. v. Cramer*, 192 U. S. 265 (1904). Petitioner's attempt to distinguish those cases from the case at bar must fail. The doctrine announced in those decisions is directly applicable to the situation existing here. *Heald v. Rice*, 104 U. S. 737 (1882).

A complete answer to all of petitioner's points is that the Court below regarded the question of patentable invention *sub judice* to be controlled by, and rested its conclusions upon, such decisions of this Court as *Altoona Public Theatres v. American Tri Ergon Corp.*, 294 U. S. 477 (1935) (mere substitution or other advance plainly indicated by the prior art); *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U. S. 84 (1941) (mere incorporation of well known element in old combination); and *Mandel Bros., Inc. v. Wallace*, 335 U. S. 291 (1948) (merely application of old process to new use and mere use of known element for same purpose).

### Conclusion.

There are not present in this case any of the grounds which the prior decisions of this Court have held were essential to move it to grant a Writ of Certiorari in a patent infringement case.

The Court of Appeals did not depart from Rule 52(a) of the Federal Rules of Civil Procedure in reviewing the prior art in a patent case where no question of credibility of a witness was involved.

The Court of Appeals decided the instant case in harmony with the decision of this Court in *Graver v. Linde*, 336 U. S. 271 (1949).

The Court of Appeals did carefully consider the prior art of record and did determine and decide that the claims were unpatentable thereover, any advantages of the patented structures being attributable to the skill of the art, not invention. In view of this holding of the Court of Appeals, each of the points raised in the petition is merely a moot question in the present case. The result reached below is in any event correct and justified.

Respectfully submitted,

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